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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,859	01/14/2000	Hideo Hagiwara	511.33114VV4	7601

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EXAMINER

CHU, JOHN S Y

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/10/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,859

Applicant(s)

NUNOMURA ET AL.

Examiner

John S. Chu

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14, 21-25, 28-31 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14, 21-25, 28-31 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This Office action is in response to the amendment received January 1, 2001.

1. The rejection under 35 U.S.C. 103(a) as given in the previous Office action over the combination of HAGIWARA ET AL, ALDRICH ET AL and MUELLER ET AL is **withdrawn** for the reasons as stated by applicant's attorney.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-14, 22 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 21 of U.S. Patent No. 5,856,059. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S. Patent 5,856,059 recite a photosensitive composition consisting essentially of a polyamic acid made by the reaction of an oxydiphthalic acid or anhydride and as a diamine a diaminopolysiloxane, an acryl compound and a photoinitiator and are obvious over the current claims. The current claims reciting a photosensitive resin composition for i-line stepper using monochromatic light, which comprises (1) a polyimide precursor, formed from an oxydiphthalic acid or acid anhydride thereof as a reactant, a 20 μ m

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film thickness of said polyimide precursor having a transmittance, at 365 nm, of at least 40%; (2) an addition-polymerizable compound; and (3) a photoinitiator. These claims are obvious over one another and a grant to the current claims extend the protection of the claims in U.S. Patent 5,856,059.

3. The rejection as given in the previous Office action Paper No. 12, paragraph 1 included a typographical error for "102(b)". The intended statute which was quoted the paragraph prior to paragraph 1 was 35 U.S.C. 102(e). The typographical error is corrected here and given under the 35 U.S.C. 102(e).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 10,11,13,14,21-25,28-30,31 and 34-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by HAGIWARA ET AL.

The claimed invention is drawn to a photosensitive resin composition which comprises (1) a polyimide precursor formed from an oxydiphthalic acid or acid anhydride thereof with a diamine, (2) an addition-polymerizable compound, and (3) a photoinitiator, and which is adapted to be exposed and developed using an i-line stepper which uses monochromatic light.

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HAGIWARA ET AL anticipates the claimed invention at Example 13 and Synthesis Example 19. The polyamic acid is a condensation product of an oxyphthalic acid and diamino diphenyl ether wherein the polyamic acid is in a composition with a tetraethylene glycol diacrylate and a photoinitiator of 4,6 dimethyl-7-ethylaminocourmarin.

The amendment to claim 25 reciting the transmittance of the composition at 365 nm for a 20 µm thick film of at least 40% is noted and is asserted to be anticipated by the prior art composition of HAGIWARA ET AL '823 due to the presence of same or similar components in the composition. Objective evidence presented in the case measuring the transmittance under the same circumstances may serve to overcome this rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on M-F from 9:30 am to 6:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John S. Chu

Primary Examiner, Group 1700

J.Chu
April 5, 2002